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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HOSSAIN, FARZANA E				
ART UNIT		PAPER NUMBER		
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06/17/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/084,722

Applicant(s)

GAVIOT ET AL.

Examiner

FARZANA HOSSAIN

Art Unit

2424

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/19/2010 has been entered.

Response to Amendment

2. This office action is in response to communications filed 05/19/2010. Claims 1, 7 and 8 are amended. Claims 2-6 have been previously presented.

Response to Arguments

3. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Claim 1, the applicant argues that Slezak does not disclose the invention in regards to switching means and Slezak does not disclose signals sent to the user to select a particular subscription and that provider transmits either a broadcast

signal having the particular event or a broadcast signal not having the particular event (Page 7-8).

In response to the argument the examiner respectfully disagrees. The language "switching means" is unclear. Based on the Office's consideration of the claim language, applicant's specification (Page 3, paragraphs 0012, 0014, Page 4, paragraph 0016) and applicant's arguments (Page 8), the Office interprets "means for switching" to be --means for selection—as the means for selection previously selected the subscription.

Slezak discloses offering a plurality of subscription and user making a choice and if the chosen subscription selectively includes an event or not; if the user is paying for the program at full cost, then advertising is not included (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4). Slezak discloses generating an information signal which has control information consisting essentially of control information and an input broadcast program (Column 8, lines 18-39, Column 9, lines 6-10, Column 3, lines 63-67, Column 4, lines 1-4). The choice of a subscription depends on the choice of whether a user wants to view a free, less expensive or more expensive programming. The subscription defines whether a program will include a particular event (or advertisement) or not. The selection means output a program with particular event or not based on the subscription selected by the selection means (Column 8, lines 18-39, Column 9, Slezak discloses a plurality of subscribers but does not specifically disclose each of a plurality of viewers are receiving the information signal. See new rejection.

4. Regarding Claim 3, the applicant argues that there is no description as to how Akamatsu can operate with Slezak to perform the limitations ("said device is configured to perform the acts of accelerated reading of a recorded program; and deactivating said accelerated reading during the particular event in respect of a specified subscription in accordance with said control information" (Page 9). The applicant further argues that Akamatsu does not supply what is missing in Slezak (Page 9).

In response to arguments, the examiner respectfully disagrees. Slezak discloses allowing accelerating of a program and not allowing or deactivating the accelerating based on the subscription (Column 9, lines 22-24, 53-60). Slezak does not explicitly disclose that the pay program can be recorded. Akamatsu allows a user to record a pay program (Column 7, lines 16-19). Slezak discloses a user system with a set top box or receiver (Figure 1, 504). Akamatsu discloses a system with a receiver and recorder (Figure 1, 100, 120). The purpose to allow a user to record pay programs instead of in the past when users illegally recorded the programs so that users are no longer inconvenienced to watch a pay program at time it is broadcasted (Column 14, lines 13-30, Column 2, lines 8-22). See response above.

5. The applicant did not argue Claims 7 and 8 specifically and the claims were not amended to incorporate all the new limitations of Claim 1. The rejection is maintained. See response above for response to Slezak arguments.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "the means for switching." There is no antecedent basis or a specific "means for switching" in the specification. Based on the Office's consideration of the claim language, applicant's specification (Page 3, paragraphs 0012, 0014, Page 4, paragraph 0016) and applicant's arguments (Page 8), the Office interprets "means for switching" to be --means for selection--.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Slezak (US 6,006,257).

Regarding Claim 7, Slezak discloses a device for presenting an output broadcast program in accordance with a subscription chosen by a user (Figure 1, 504, Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4), the device comprising:

means for receiving an information signal or the receiver (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7, Column 9, lines 6-10) receiving an information signal consisting essentially of control information including a message and signals allowing users to choose between subscriptions and movies and information allowing a user to forward shift a video or not forward shift a video based on the subscription (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Column 9, lines 6-10, 39-55, Figure 7) and an input broadcast program having at least one particular event or an advertisement (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7); and

Means for selecting the particular event in dependence on the control information, the selection means configurable by a provider of the information signal to be responsive to the control information on the basis of the subscription chosen by the user (Column 8, lines 18-39, remote control unit, keyboard, mouse, Column 3, lines 63-67, Column 4, lines 1-4, Figure 1, 504, Figure 7) for at least one of various durations as there is a pay level without commercials (the program only), discounted pay level (some commercials with the program) and a free level (more commercials with the program) (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7),

Wherein the selecting means (Column 8, lines 18-39, remote control unit, keyboard, mouse) operates on the input program having at least one particular event to

selectively provide the output broadcast program (Column 8, lines 18-39, remote control unit, keyboard, mouse, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7), the particular event being included or not included in the output broadcast program according to the subscription chosen by the user in accordance with the control information based on the control information or information that determines which subscription the user will select and may or may not include the particular event or advertisement (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 1, 5042) in dependence on the configuring of the selecting means by the provider according to the subscription chose by the user (Column 8, lines 18-39, Column 9, lines 38-56).

Regarding Claim 8, Slezak discloses a device for presenting an output broadcast program (Figure 7, Figure 1, 500, 502, 504), the device comprising:

means for receiving an information signal (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7, Column 9, lines 6-10) consisting essentially of control information including the control screen and signals allowing users to choose between subscriptions and movies and information allowing a user to forward shift a video or not forward shift a video based on the subscription (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Column 9, lines 6-10, 39-55, Figure 7) and an input broadcast program having at least one particular event or an advertisement (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7, Column 9, lines 6-10);

Means for selecting the particular event in dependence on the control information (Column 8, lines 18-39, remote control unit, keyboard, mouse, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7), the selection means being configurable by a provider of the information signal to be responsive to the control information on the basis of the subscription chosen by the user (Column 8, lines 18-39, remote control unit, keyboard, mouse, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7) for at least one of various durations as there is a pay level without commercials (the program only), discounted pay level (some commercials with the program) and a free level (more commercials with the program) (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7);

Wherein the selecting means operates on the input program having at least one particular event to selectively provide the output program (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7), the particular event being included or not included in the output program according to the subscription chosen by the user in accordance with the control information based on the control information or information that determines which subscription the user will select and may or may not include the particular event or advertisement (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7) depending on the configuring of the selecting means by the provider according to the subscription chose by the user (Column 8, lines 18-39, Column 9, lines 38-56).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak in view of Eyer et al (US 6,588,015 and hereafter referred to as "Eyer").

Regarding Claim 1, Slezak discloses a method using a telecommunication system (Figure 1) to enable a service provider (Figure 1, 510, 520) to differentiate among a plurality of subscriptions originated by a plurality of users to a service in respect of processing one or more input broadcast programs (Column 3, lines 63-67, Column 4, lines 1-4), each input broadcast program comprising at least one particular event (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4), the method comprising:

Offering the plurality of subscriptions having various subscriptions durations to each of a plurality of users as there is a pay level without commercials (the program only), discounted pay level (some commercials with the program) and a free level (more commercials with the program) (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Column 5, lines 11-26);

a user making a choice of subscription using a device comprising means for effecting the choice, the device further comprising means for selecting (Figure 1, 504, Column 8, lines 18-39, remote control unit, keyboard, mouse, Column 3, lines 63-67, Column 4, lines 1-4); and

Validating the user's choice of subscription and configuring the means for selecting to be responsive to the control information in dependence on the subscription choice (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4);

Generating an information signal (Column 8, lines 18-39, Column 9, lines 6-10, 39-55) consisting essentially of control information (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Column 9, lines 6-10, 39-55) and an input broadcast program comprising at least one particular event (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4);

Transmitting the information signal to the user making the selection (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7);

At the user's location, operating the input broadcast program comprising at least one particular event the means for selecting (Column 8, lines 18-39, remote control unit, keyboard, mouse) in dependence on the control information to selectively provide an output broadcast program or the input program relies on the program including the advertisement (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4), the particular event being included or not included in the output broadcast program in accordance with the control information or based on the control information or information that determines which subscription the user will select and may or may not

include the particular event or advertisement in dependence on the configuring of the means for switching according to the chosen subscription (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4).

Slezak is silent on each user making a choice of subscription, transmitting the information signal to each of the plurality of users and at each user's location operating means to output the program in dependence with means for selecting according to the chosen subscription.

Eyer discloses a provider differentiating among a plurality of subscriptions originated by a plurality of users to service in respect of processing of one or more input broadcast programs, each input broadcast program comprising at least a particular event (Column 4, lines 11-17, Column 5, lines 46-56); each user making a choice of subscription (Column 6, lines 56-61, Column 17, lines 13-21 – each paying user of a plurality of paying subscriber or each nonpaying user of a plurality of nonpaying subscribers) and at each user's location, operating the input broadcast program comprising at least one particular event using the means for selecting in dependence on the control information to selectively provide an output broadcast program, in dependence with means for switching/selecting according to the chosen subscription (Column 16, lines 28-60, Column 17, lines 13-21, Columns 18-19, Table 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify Slezak to include each paying user of a plurality of paying subscriber or each nonpaying user of a plurality of nonpaying subscribers) and at each user's location, operating the input broadcast program comprising at least one particular event using the

means for selecting in dependence on the control information to selectively provide an output broadcast program, in dependence with means for switching/selecting according to the chosen subscription (Column 16, lines 28-60, Column 17, lines 13-21, Columns 18-19, Table 1) as taught by Eyer in order to provide the user with options of service tiers for marketing purposes (Column 2, lines 44-60) as disclosed by Eyer.

Regarding Claim 2, Slezak and Eyer disclose all the limitations of Claim 1. Slezak discloses that the control information contains a table of events or a database of advertisements (Column 6, lines 15-24, 38-47, Column 8, lines 43-53). It is necessarily included that a database is organized structure of information which can be interpreted to be a table of information. Slezak discloses an act of selecting a particular event on the basis of an event status value in the table or database (Figure 7, Column 9, lines 2-20, Column 8, lines 18-53).

Regarding claim 4, Slezak and Eyer disclose all the limitations of Claim 1. Neel discloses the particular event includes at least one advertisement (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4),).

Regarding claim 5, Slezak and Eyer disclose all the limitations of Claim 1. Neel discloses the act of the user making the choice of the subscription comprises an act of selecting one subscription from among several subscriptions including different programs and a pay level and free level for the different programs offered on a graphics interface in communication with the device (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4), 4).

Regarding claim 6, Slezak and Eyer disclose all the limitations of Claim 1.

Slezak discloses the validating step is implemented by the service provider by sending the device a signal characteristic of the chosen subscription (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4), the signal being suitable for configuring the means for selecting as a function of the chosen subscription as the service provider sends either the paid version of the program, discount version or the free version with the particular event (Column 8, lines 18-39, Column 3, lines 63-67, Column 4, lines 1-4, Figure 7).

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak in view of Eyer, as applied to claim 1, further in view of Akamatsu et al (US 7,257,132 and hereafter referred to as "Akamatsu").

Regarding Claim 3, Slezak and Eyer disclose all the limitations of Claim 1.

Slezak discloses the device comprises means for accelerated reading of the program (Column 9, lines 22-24); and means for deactivation for deactivating the accelerated reading means (fast-forwarding) of the program during the particular event in respect of a specified subscription in accordance with control information or control data defining the subscription as a one which a viewer must view the advertisement to get a free or reduced cost programming and a forward shift is not allowed until the must view event is viewed. (Column 9, lines 53-60). The combination does not explicitly disclose that a pay program can be recorded therefore, recording the program. In analogous art, Akamatsu disclose a pay program can be recorded therefore, recording the program

(Column 7, lines 16-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the to include a pay program can be recorded therefore, recording the program (Column 7, lines 16-19) as taught by Akamatsu in order to allow a user to record pay programs without illegally recording pay programs (Column 14, lines 13-30) as taught by Akamatsu.

Double Patenting

12. Applicant is advised that should claim 7 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA HOSSAIN whose telephone number is (571)272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/FARZANA HOSSAIN/
Primary Examiner, Art Unit 2424

June 10, 2010